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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/764,660

01/26/2004

Soon-hac Hong

P2067US

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8968 7590 10/14/2009
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EXAMINER

WIENER, ERIC A

ART UNIT

PAPER NUMBER

2179

MAIL DATE

DELIVERY MODE

10/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/764,660	Applicant(s) HONG, SOON-HAC	
	Examiner Eric Wiener	Art Unit 2179	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-4, 6, 7, 9-17, 19-21 and 24.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 20090818
13. ☐ Other: _____.

/Weilun Lo/
 Supervisory Patent Examiner, Art Unit 2179

/Eric Wiener/
 Examiner, Art Unit 2179

Continuation of 3. NOTE:

The proposed amendments to independent claims 1, 12, and 20 change the scope of claims 1, 12, and 20 as well as the scope of dependent claims 2-4, 7, 9-11, 13-15, 17, 19, 21, and 24; which would require further consideration and/or search.

The proposed amendment to independent claim 20 raises new issues within the claim to a digital camera of claim 20, as well as within claims 21 and 24 that depend from claim 20, which would require further consideration and/or search.

Continuation of 11. NOTE:

1. The Applicant has argued that "The combination of references fails to teach or suggest a user-alterable reference number, as required by the amended claims."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "user-alterable") are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2. The Applicant has argued that "the Constitution of Hong is silent as to how the reference number is set."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "how the reference number is set") are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

3. The Applicant has argued that "According to one of ordinary skill in the art and the cited prior art, threshold reference values for menu modifications are established prior to manufacture or use of the camera, and not by the users themselves. By permitting the users to set their own thresholds that trigger a menu modification, a choice is left to the user as to how influential the user's menu choices are in rearranging pre-established menu organizations. This is not taught or suggested in the prior art, nor would it be an obvious variation to one of ordinary skill in the art in view of art in which predefined thresholds dictate the influence of the user's menu choices in rearranging the pre-established menu organizations.

This is simply an aspect not taught by the combination of references, and not something that one of ordinary skill in the art, who would be seeking to minimize complexity and cost of the device, would arrive at unless such a beneficial outcome was recognized - which can only be derived from the teaching of the present specification."

In response to applicant's argument that "by permitting the users to set their own thresholds that trigger a menu modification, a choice is left to the user as to how influential the user's menu choices are in rearranging pre-established menu organizations" and further that "one of ordinary skill in the art [] would be seeking to minimize complexity and cost of the device," the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Furthermore, the Applicant has not provided explicit evidence or citations, either in the prior art or Applicant's disclosure, to support the conclusion that "According to one of ordinary skill in the art and the cited prior art, threshold reference values for menu modifications are established prior to manufacture or use of the camera, and not by the users themselves."

The Applicant has also not provided explicit evidence or citations, either in the prior art or Applicant's disclosure, to support the conclusion that "This is [] not taught or suggested in the prior art, nor would it be an obvious variation to one of ordinary skill in the art in view of art in which predefined thresholds dictate the influence of the user's menu choices in rearranging the pre-established menu organizations."

The Applicant has also not provided explicit evidence or citations, either in the prior art or Applicant's disclosure, to support the conclusion that "This is [] not something that one of ordinary skill in the art [] would arrive at unless such a beneficial outcome was recognized - which can only be derived from the teaching of the present specification."

4. The Applicant has argued that "Hong fails to disclose comparing a number of use values for each menu item with a reference number, but rather discloses a number of uses of a camera by a particular user."

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

5. The Applicant has argued that "The combination of references fails to teach or suggest 'a number of uses value for each menu item by totaling the number of times each menu item has been used across the plurality of operation modes.'"

In response to this argument, the Examiner respectfully disagrees. Please refer to Sugimoto, column 7, line 57 - column 8, line 23; wherein Sugimoto discloses two "modes" that pertain to two different possible ways that menu items are changed. One "mode" changes menu items whenever the camera is "powered" and the other "mode" changes menu items whenever the camera takes a picture, upon "each capturing time." Therefore, it has been interpreted that the option to change the menu items whenever the camera is "powered," means that menu items may change at all times and in all operating modes that may be used while the camera is "powered," and thus the menu items may change across the plurality of operating modes and the number of uses values may be totaled across the plurality of operating modes.